

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

REMARKS

Claims 2-13, 15-18, and 21-25 are currently pending in the application. In view of the remarks that follow, Applicants respectfully request further and favorable consideration.

Election/Restriction Requirement

The Office Action asserts that it is setting forth an election-of-species requirement, where the species are defined as:

1. A method of manufacturing a semiconductor device having a gate structure and an interconnect layer, utilizing CMP (Claims 2-13, 15-18).
2. A method of planarizing topographic features on a substrate using a rotatable polishing head (Claims 21-25).

However, this requirement is respectfully traversed, because it is not in proper form. In this regard, Applicant's traverse is not directed to the issue of whether or not these species are patentably distinct. Instead, Applicants are respectfully pointing out that the Office Action fails to properly identify any "species" upon which an election-of-species requirement can properly be based. MPEP §806.04(e) emphasizes with italics that:

Claims are definitions of inventions. *Claims are never species . . .*
Species are always the specifically different embodiments.
(Emphasis in original).

The present Office Action attempts to identify two "species", solely by reference to the claims. In particular, the Office Action attempts to identify a first "species" by listing one group of

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claims and paraphrasing some language from them, and attempts to identify a second "species" by listing a second group of claims and paraphrasing some language from them. In essence, the Office Action asserts that certain claims constitute one species, and that other claims constitute a second species. But this approach is specifically prohibited by MPEP §806.04, which emphasizes that "*Claims are never species*". This improper approach also causes the Office Action to have internal inconsistencies. For example, the Office Action specifies which claims go with which species, but then instructs Applicants to provide "a listing of all claims readable" on the elected species, or in other words a listing of all claims readable on the claims identified by the examiner. This makes no sense (and the reason is that the Office Action does not actually identify any true "species" in the first place, because species "*are always the specifically different embodiments*", rather than groups of claims). Official PTO policy specifies that, in the vast majority of patent applications, the proper way to identify different species is by identifying different drawing figures (or by identifying different examples in the case of a chemical invention). More specifically, MPEP §809.02(a) explains that, in a proper election-of-species requirement:

The species are preferably identified as the species of figures 1, 2, and 3 or [in a chemical case] the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.
 (Emphasis in original).

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In other words, if it is possible to do so, the examiner must identify species by figure numbers. In the rare event that it is simply not possible to identify species by figure numbers, then and only then the examiner may identify a species by mechanical means, particular material, or other distinguishing characteristic. And in the extremely rare event that species "*cannot be conveniently identified*" in any of these various different ways, then and only then the examiner may group claims (but even then it must be remembered that "*Claims are never species*" and that the claims must be grouped "in accordance with the species", as opposed to using the claims to define the species).

As a practical matter, it is an extremely rare situation where an examiner is able to carry the burden of showing that species "*cannot be conveniently identified*" in any of the various different ways preferred by MPEP §809.02(a), such that the examiner can resort to grouping claims. In the present Office Action, the Examiner has not carried the burden of demonstrating that species "*cannot be conveniently identified*" in any of the various different ways preferred by the PTO. Accordingly, the Examiner was not entitled to resort to grouping claims. The Office Action therefore fails to properly identify any species upon which an election-of-species requirement could properly be based. The purported election-of-species requirement is thus inherently defective, and it is respectfully submitted that it must be withdrawn.

Since the Examiner has chosen to group claims here, rather than identify true species, the so-called election-of-species requirement in the Office Action is actually a restriction requirement rather than an election-of-species requirement (because an examiner is in fact allowed to group claims in a restriction requirement). But to the extent that the present Office Action is actually attempting to set forth a restriction requirement, it does not do so properly, because it fails to meet all of the requirements for a proper restriction. In this regard, MPEP §817 deals with restriction requirements, and specifies that a proper restriction requirement must:

1. Identify each claim group by Roman numeral.

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2. List the claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.
3. Give a short description of the total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product.
4. Classify each group.

The present Office Action meets requirement (2), in particular by grouping claims. However, the present Office Action fails to satisfy requirements (1), (3) and (4), because it fails to identify each group by Roman numeral, indicate why the claim groups set forth different inventions, or identify the class and subclass applicable to each group. Accordingly, the present Office Action not only fails to set forth a proper election-of-species requirement, but also fails to set forth a proper restriction requirement. For the foregoing reasons, it is respectfully submitted that the improper requirement must be withdrawn, and notice to that effect is respectfully requested.

The PTO requires that Applicants reply to a restriction requirement or an election-of-species requirement, even if Applicants offer a valid traverse. Accordingly, as between the claim groups set forth in the Office Action, Applicants elect Group 1 (Claims 2-13 and 15-18). Obviously, Claims 2-13 and 15-18 all read on the so-called "species" of Claims 2-13 and 15-18. Further, since so-called "species" 1 is defined by the Examiner to involve "CMP", and since so-called "species" 2 is defined by the Examiner to be "planarizing topographic features on a substrate using a rotatable polishing head", which is inherently encompassed within the term "CMP", it is respectfully submitted that Claims 2-13 and 15-18 are all necessarily generic to both of the so-called "species".

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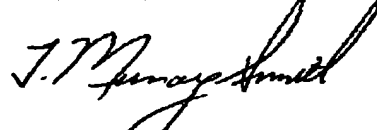
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Conclusion

In view of the foregoing, it is respectfully requested that the election/restriction requirement is defective and must be withdrawn, and that all of the pending claims should be examined on the merits. Further and favorable consideration of this application is respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Although Applicants believe that no fee is due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Enclosures: None

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